

REMARKS

Claims 33-56 were previously pending in this application, claims 7-10, 18-23, and 29-32 having been withdrawn from consideration.

In order to advance the prosecution of this application, claims 33-38 and 41 are hereby cancelled and independent claims 39, 46, and 51 have been amended to better define the invention and to define over the applied prior art.

Claims 33-45 and 51-56 have been rejected under 35 U.S.C. 103(a) as obvious over Vasnier in view of Japanese document 63-168755 and newly cited Desblancs. Claims 46-50 have been rejected under 35 U.S.C. 103(a) as obvious over Vasnier, Japanese, Desblancs, and Erola. Claims 33-45 and 51-56 have been rejected under 35 U.S.C. 103(a) as obvious over Sarskog in view of Vasnier and Desblancs.

Claim Rejections - 35 U.S.C. § 103(a) (all rejections will be discussed together)

Regarding independent claims 39, 46, and 51, Applicant has made significant amendments to distinguish the claimed invention over the prior art. First, the backup memory is specified to store the data for the purpose of backup, and the processor is characterized to control the backup operation between the SIM card and the backup memory. The backup operation is performed by the backup processor based on the instruction inputted by the information changing input or means for information extracting. Second, the execution of backing up data between two different SIM cards of the communication device, PDA, or backup device of the claimed invention is free of using an RF (radio frequency) transceiver. Thus, the information changing transferred from the first SIM

card or into the second SIM card is wired and performed within the identical device. The transferred data will not be transferred through the air or by radio frequency transmission.

The invention defined in claims 39, 46, and 51 could enable the device or PDA to backup or restore the data according to the instructions inputted through the information changing input for inputting or changing any kind of information changing or the information extracting means for selecting and drawing out the backup data.

From the description of the present invention (specification [0014], lines 17 to 19), a backup connector of the claimed invention is allowable for inserting a plurality of first and second SIM cards to transfer the backup data transferred from the plurality of first SIM cards into the plurality of second SIM cards. In Applicant's view, Vasnier merely discloses a method of transferring information between a subscriber identification model and a mobile terminal constituting a station of a radio-communication system. Please refer to column 3, lines 52-55 of Vasnier, where it recites that "it controls a transfer device 27 associated with contact elements 211 that come into contact with the contact areas of a SIM card inserted into the terminal." By contrast, in one embodiment, the backup connector of the claimed invention may be simultaneously used for inserting a first SIM card and a second SIM card, thereby transferring the backup data between the first SIM card and the second SIM card. In other words, the single SIM card of Vasnier is inserted into the only corresponding one contact element 211 of the mobile terminal 20. Therefore, the contact element 211 of Vasnier and the backup connector of the claimed invention are totally different.

Moreover, it should be noted that the backup mechanism and the manipulation of backup operation of the claimed invention include the information changing input for inputting instructions and inputting or changing any kind of the backup data, and the

information extracting means for extracting (the extract refers to select and draw forth) the backup data, thereby restoring the extracted data transferred from the first SIM card to the second SIM card according to the inputting instructions. In other words, the backup data may be transferred by means of selecting data from the first SIM card by the information extracting means, editing the data by the information changing input, and then backing up the data to the second SIM card. Such is a crucial technical feature of the claimed invention. Please refer to column 4, lines 10-15 of Vasnier, where it recites that “a situation in which the user has just pressed keys on the keypad 29 to make an outgoing call. The last key pressed is a confirmation key and causes the terminal to alert the SIM card to check if the call is authorized or not, and in the case of a prepaid card to check whether the remaining credit is sufficient for the call.” In other words, the keypad 29 of Vasnier is actually a mobile terminal function key, and it processes a totally different function with the information changing input and the information extracting input of the claimed invention. In fact, there is no evidence showing that the keypad 29 of Vasnier possesses the function of the information changing input of the claimed invention. Therefore, Vasnier fails to disclose or suggest this technical feature.

The Japanese document discloses a device for transferring data from one IC card to another IC card. Applicant emphasizes that a backup connector of the claimed invention may hold a plurality of first SIM cards. The manipulation of backup operation of the claimed invention is utilized by the information changing input and the information extracting input, and therefore the partial selected and drawn out extracted data may be transferred from the plurality of the first SIM cards to different second SIM cards, respectively, thereby creating a variety of combination backup data. In other words, Applicant’s invention may extract partial data of the first SIM card by information extracting means with instructions for transferring into one of the

plurality of the second SIM cards. Similarly, after carefully reviewing by the Applicant, the backup of the Japanese document is merely transferred between two IC cards instead of SIM cards. Importantly, the IC card has no security and identify function. Further, it relates to all data backup free of partial data backup of the claimed invention. No extraction function is provided by the cited prior art. Therefore, Japanese document does not disclose the matters of a plurality of SIM cards, data backup, backup program, the information changing input, and the information extracting means of the claimed invention. Accordingly, citation of Japanese document fails to disclose the above-mentioned technical feature. The result of the claimed invention cannot be expected from a combination of Vasnier with the Japanese document.

Desblancs discloses a method of delivering a telephone number associated with a telephone subscription to the user of a telephone set. Please refer to column 3, lines 23-27 of Desblancs, where it recites that “In a practical implementation of the method of the invention,” when the mobile telephone 1, 20 is switched on by action on the ON/OFF button 19, the user must initially insert the SIM card 3 in the reader 6 provided for this purpose and use the keypad 7 to key in a personal identity number (PIN), as with an automatic teller machine (ATM) in a bank.” Similarly, the keypad 7 of Desblancs is actually a mobile telephone function key, and it processes a totally different function with the information changing input and the information extracting input of the claimed invention. Moreover, the SIM card 3 of Desblancs is similar to that of Vasnier inserted in the card reader 6. Therefore, the card reader 6 of Desblancs and backup connector of the claimed invention are also totally different. Accordingly, citation of Desblancs fails to disclose this technical feature.

Erola discloses a method for conveying control commands for a SIM card from external apparatus to the SIM card. Please refer to column 11, lines 8-17 of Erola, where it

recites that “However, the invention is not limited to the use of an ordinary mobile station, but the host device may be a multi-purpose mobile communication device, a so-called personal digital assistant (PDA) or another apparatus employing a SIM card or another smart card.” The SIM card used in the PDA of Erola is merely applied for identification, which is the basic function of a SIM. With the same reason described above, citation of Vasnier does not disclose this technical feature of the claimed invention after carefully reviewing by Applicant.

Sarskog discloses a method for the safe storage of information, wherein the information content between two different SIM cards is transferred by the computer via a mobile telephone system. In other words, the information content transfer of two different SIM cards of Sarskog is finished by employing a remote server, and the backup procedure should be carried out through the mobile communication system. By contrast, according to the claims herein, the backup data transfer between the first and second SIM cards is finished by a personal digital assistant (PDA) or the communication device itself. Therefore, the backup mechanism and the manipulation of backup operation of the personal digital assistant (PDA) or communication device of the claimed invention is totally different from that of Sarskog. From the citation, the information has to be transferred from the radio frequency transceiver and through the air. A long-distance remote terminal or computer and card reader are needed. Therefore, it cannot provide the in-situ backup function as claimed by Applicant in the amended claims. The present invention improves the efficiency and it is convenient for in-situ backing up the data within the identical device. The result cannot be expected by Sarskog.

Moreover, data backup of the claimed invention is free of the wireless RF transmission and the backup memory is stationary in the personal digital assistant (PDA) or communication device rather than remote terminal, and therefore the backup data transfer between the first and second SIM cards can reach a real-time transfer level. Similarly, there is no evidence showing that Sarskog possesses the function of the backup connector of the claimed invention. Accordingly, citation of Sarskog also fails to disclose or suggest the above-mentioned technical feature of the claimed invention.

Applicant emphasizes that the execution of backing up data between two different SIM cards of the communication device, PDA, or backup system of the claimed invention is free of using RF (radio frequency) transceiver. The suggested combination, variously, of Sarskog, Japanese document, Desblancs, Erola, and Vasnier would impose unnecessary cost or inconvenience to the user, since the user cannot backup or restore the data free of the control of the mobile service provider. In contrast, the present invention enables the user to backup as well as restore data in any time and any place in the identical device, even in the place out of mobile service. No additional fee is required. Such effect is certainly unexpected to the known prior art. Accordingly, the claimed invention possesses unexpected result over the prior art.

According to the above-mentioned, it is apparent that the backup mechanism and the manipulation of backup operation provided by the claimed invention are unexpected to the prior art, and all of the citations fail to disclose such characteristics of the present invention, even combining all of the citations. Moreover, there is no suggestion or motivation, apart from the application of hindsight, to combine Sarskog, Japanese document, Desblancs, Erola, and Vasnier for achieving the claimed invention. Such

technical feature is significant to the present invention, but absent in the prior art. Pursuant to *In re Papesch*, “the presence of a property not possessed by the prior art is evidence of nonobviousness,”¹ the combination of the Sarskog, Japanese document, Desblancs, Erola, and Vasnier cannot render the present invention obvious or unpatentable. Thus, claims 39, 46, and 51 are unobvious and patentable over the citations of prior art.

Since claims 40-45, 47-50, 52-56 respectively depend on claims 39, 46, and 51, they should be patentable for at least the same reasons.

Applicant believes that the response traverses the rejections under 35 U.S.C. 103. Reconsideration and withdrawal of the rejections set forth in the Office Action are respectfully requested.

¹ *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)


CONCLUSION

In view of the foregoing, it is believed that claims 39, 40, and 42-56, now pending in this application, comply with all the requirements for patentability and define over the applied art. A Notice of Allowance is, therefore, respectfully requested. Should any issues remain unresolved, the Examiner is invited to telephone the undersigned attorney.

The Commissioner is hereby authorized to charge any fees that arise in connection with this filing which are not covered by the money enclosed, or credit any overpayment, to Deposit Account No. 02-0460.

Respectfully submitted,

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